

REMARKS

The amendments made herein are the same as those made in the previous after-final response (which amendments were not entered) and, as acknowledged in the Advisory Action mailed September 6, 2011, obviate the 102(e) rejection.

With respect to the obviousness rejection over Biwersi, the applicants maintain their previous arguments and respectfully disagree with the Office's arguments in the Advisory Action.

The Advisory Action asserted that the claims as amended differed from a compound of Biwersi (Example 136) by requiring, *inter alia*, an alkyl moiety at the R³ position, where the compound of Example 136 of Biwersi had a hydrogen at that position. The Advisory Action then asserted that substitution of an alkyl for a hydrogen would have been obvious absent unexpected results.

The applicants respectfully submit that the Office's reasoning falls short of the legal requirements for establishing obviousness of a chemical compound, which requires the Office to articulate a reason that one of ordinary skill in the art would have selected Biwersi Example 136 for modification.

[P]roof of obviousness based on structural similarity requires clear and convincing evidence that a medicinal chemist of ordinary skill would have been motivated to select and then to modify a prior art compound (e.g., a lead compound) to arrive at a claimed compound with a reasonable expectation that the new compound would have similar or improved properties compared with the old." *Daiichi Sankyo Co. v. Matrix Laboratories Ltd.*, 619 F.3d 1346, 1352 (Fed. Cir. 2010) (emphasis added); *Eisai*, 533 F.3d at 1359 (emphasis added) ("...post-KSR, a prima facie case of obviousness for a chemical compound still, in general, begins with a reasoned identification of a lead compound.") (Emphasis added.)

The Office has provided no basis for selecting Example 136 to compare to the present claims. And the applicants submit that there is nothing in Biwersi that distinguishes the compound of Example 136 in any manner that would bring it to the attention of one of ordinary skill in the art, much less suggest it for modification in any manner or, in particular, a manner that would lead to the compounds recited in the present claims.

Without a reason to select the compound of Example 136 from the 170 specific compounds disclosed in Biwersi, the present claims cannot be obvious.

In view of the forgoing, therefore, the applicants respectfully request withdrawal of the obviousness rejection.

If there are any questions or comments regarding this application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: October 3, 2011

/Michael S. Greenfield/
Michael S. Greenfield
Registration No. 37,142

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606